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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ralph D. Gelling 3 Pickwick Way Wayland, MA 01778			EXAMINER LE, LINH GIANG	
			ART UNIT 3686	PAPER NUMBER
			MAIL DATE 11/10/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,346

**Applicant(s)**

STEIN ET AL.

**Examiner**

MICHELLE LE

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to Remarks filed 31 July 2009. Claims 1-46 remain pending.

***Claim Rejections - 35 USC § 112, Second Paragraph***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 has been amended to overcome the previous rejection and the rejection under 35 USC 112 paragraph 2 is hereby withdrawn.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer (6208973) in view of Dvorak (2002/0120472).

6. As per claim 1, Boyer teaches a system for processing health care insurance claims among a health care service provider, a patient and said patient's insurance carrier comprising:

a provider server, (Boyer, Col. 6, lines 23-40), said provider server further comprising:  
a provider storage medium for storing patient data and adjudication software received from a remote source (Boyer, Col. 6, lines 23-40; Boyer; Col. 8, lines 56-67);

a provider payment determination processor operatively associated with said storage medium to process patient data, using said payment adjudication software to obtain an adjudicated payment request (Boyer; Col. 7, lines 25-40);

a provider communication interface for receiving data and sending data including said payment request over an external communication link in a secure manner (Boyer; Col.7, lines 10-25); and

a carrier server operatively established at the insurance carrier (Boyer; Col. 7, lines 52-67), said carrier server further comprising:

a carrier storage medium for storing an authoritative version of patient data and insurance payment adjudication software (Boyer; col. 8, lines 27-42);

a carrier payment administration processor for receiving said payment request and causing a payment to be made to said provider in accordance with said claim submittal (Boyer; Col. 7, lines 52-67); and

wherein said communication link connects said provider and carrier servers through said provider and carrier communication interfaces (Boyer; Col.7, lines 10-25).

Boyer does not expressly teach the service provider operatively established at the health care service provider. However Examiner submits that this is an intended use of the claimed invention. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although the server containing the storage medium and payment determination processor is located at the "internet bank" in Boyer it still meets the structural limitations of the claimed invention. The Internet Bank in Boyer has a database to store patient data (Boyer; Col. 8, lines 56-67; reads on "provider storage medium") and a processor to adjudicate a payment request (Boyer; Col. 7, lines 40-50). The fact that the "internet bank" is located elsewhere does not exclude it from being prior art as the location of the database and processor is merely an intended use of these structures. The internet bank is capable of performing the processing and thus reads on the claim.

Furthermore, the features of having a provider storage medium and provider payment determination processor located at a health care service provider are old and well known in the art as evidenced by Patricelli. In particular, Patricelli teaches the server at the service provider containing a database and adjudication processor (Patricelli; paras. 30 and 31). The service provider may include physicians, hospitals, ambulatory surgery centers etc...(Patricelli; para. 26; reads on "health care service

provider") It would have been obvious to one of ordinary skill in the art to include the server at a health care service provider of Patricelli to the Boyer payment system as the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

Boyer does not expressly teach a carrier communication interface for receiving data including said payment request and sending data over said external communication link in a secure manner. However this feature is well known in the art as evidenced by Dvorak. In particular, Dvorak teaches a security system manager (Dvorak; para. 42). It would have been obvious to add this feature to the Boyer teachings with the motivation of reducing erroneous security access (Dvorak; para. 30).

7. As per claim 2, Patricelli teaches a system for processing health care insurance claims, according to claim 1, wherein said provider server further comprises a data reader/writer and wherein said remote source of patient data and adjudication software is a portable device with storage capability and said patient data and adjudication software is downloaded to the provider storage medium by reading said data from said device (Patricelli; paras. 29-31). It would have been obvious to one of ordinary skill in the art to include the server at a health care service provider of Patricelli to the Boyer payment system as the claimed invention is merely a combination of old elements, and

in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

8. As per claim 3, Boyer teaches a system for processing health care insurance claims, according to claim 2, wherein said portable device is a smart card (Boyer; Col.7, lines 10-25).

9. As per claim 4, Boyer teaches a system for processing health care insurance claims, according to claim 2, wherein said portable device is a magnetic media card (Boyer; Col.7, lines 10-25).

10. As per claim 5, Patricelli teaches a system for processing health care insurance claims, according to claim 1, wherein said remote source of patient data and adjudication software is said carrier storage medium and said patient data and adjudication software is downloaded to said provider server from said carrier server over said communication link (Patricelli; paras. 29-32). It would have been obvious to one of ordinary skill in the art to include the server at a health care service provider of Patricelli to the Boyer payment system as the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

11. As per claim 6, Patricelli teaches a system for processing health care insurance claims, according to claim 1, wherein said remote source of patient data and adjudication software is an Internet site and said patient data and adjudication software is downloaded to said provider server over said communication link from an Internet site (Patricelli; para. 36). It would have been obvious to one of ordinary skill in the art to include the server at a health care service provider of Patricelli to the Boyer payment system as the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized the results of the combination were predictable.

12. As per claim 7, Boyer teaches a system for processing health care insurance claims, according to claim 1, further comprising:  
a system for processing claims for treatment plans (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67; Col. 8, lines 27-55), wherein said claims require expert review comprising:  
a provider expert review processor, operatively associated with said provider server, for securely storing and processing a treatment plan file, said file including treatment plan and supporting data (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67; Col. 8, lines 27-55);  
a carrier expert review processor, operatively associated with said carrier server, for



providing processing and memory resources to support the process of conducting said expert review (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67);

an expert review server operatively associated with said provider and carrier expert review processors through said communication links, for providing processing and memory resources to support the process of conducting said expert review (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67);

further wherein said provider and carrier expert review processors and said expert review server cooperate to provide access to a listing of claims for review, provide processing of applications by experts for reviewing a particular claim, provide assignment of said claim to said expert and provide access by said assigned expert to said treatment plan file to conduct said review (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67);

and an expert review module connected by said communication link to provide a means for said assigned expert to access said provider expert review server, review said treatment plan file, and generate a report (Boyer; Col. 7, lines 10-67; Col. 14, lines 54-67).

13. As per claim 8, Boyer teaches a system for processing health care insurance claims, according to claim 7, wherein said expert review server comprises a web site (Boyer; Col. 7, lines 10-67).

14. As per claim 9, Boyer teaches a system for processing health care insurance claims, according to claim 8, wherein said web site is on said provider server and accessible through said communication link (Boyer; Col.7, lines 10-67).

15. As pre claim 10, Boyer teaches a system for processing health care insurance claims, according to claim 1, wherein said provider server further comprises a coordination of benefits processor for processing claims in which the patient is covered by multiple carriers, said processor constructed to identify said multiple carriers, obtain and segregate patient data and adjudication software relative to patient and each carrier, cause said provider payment processor to sequentially process said claims using the patient data and adjudication software of each of said multiple carriers and for allocating the payments to each carrier according to a predetermined priority of said carriers (Boyer; Col.7, lines 10-67; Col. 15, lines 53-65).

16. As per claim 11, Boyer teaches a system for processing health care insurance claims, according to claim 1, wherein said provider server further comprises a user interface constructed to enable a user to enter data and commands, and to observe a visual display of operational information (Boyer; Col.7, lines 10-67)..

17. As per claim 12, Boyer teaches a system for processing health care insurance claims, according to claim 1, wherein said provider server further comprises a provider

patient data and adjudication software update processor constructed to send an inquiry to said carrier server to obtain a current version of said patient data and adjudication software (Boyer; Col. 10, lines 54-67).

18. As per claim 13, Boyer teaches a system for processing health care insurance claims, according to claim 12, wherein said provider update processor is adapted to update a portable source of patient data after receiving said current version of said patient data and adjudication software (Boyer; Col. 10, lines 54-67).

19. As per claim 14, Boyer teaches a system for processing health care insurance claims, according to claim 1, wherein said carrier server further comprises a carrier patient data and adjudication software update processor to process said inquiry from said provider server and send a current version of said patient data and adjudication software to said provider server (Boyer; Col. 10, lines 54-67).

20. As per claim 15, Boyer teaches a system for processing health care insurance claims, according to claim 14, wherein said carrier patient data and adjudication software update processor is the gatekeeper to control access to said carrier storage medium (Boyer; Col. 10, lines 54-67).

21. As per claim 16, Boyer teaches system for processing health care insurance claims, according to claim 14, wherein said carrier patient data and adjudication software update processor is constructed to determine whether said inquiries are for complete patient data files or complete adjudication software, or whether said inquiries are to check for the currency of data and software currently available at the provider server, and wherein said carrier update processor is further constructed to send an update or complete patient data and adjudication software package according to said inquiry (Boyer; Col. 10, lines 54-67).

22. As per claim 17, Dvorak teaches a system for processing health care insurance claims, according to claim 1, wherein said provider and carrier communication interfaces provide security functions to protect and to keep private any data in transit, in processing, or in storage (Dvorak; paras. 30, 42-43). It would have been obvious to add this feature to the Boyer teachings with the motivation of reducing erroneous security access (Dvorak; para. 30).

23. As per claim 18, Boyer teaches system for processing health care insurance claims, according to claim 17, wherein said security functions include at least, encryption and decryption, identity verification, and data authentication (Boyer; Col. 14, lines 33-40).

24. As per claim 19, Dvorak teaches a system for processing health care insurance claims, according to claim 1, wherein said security functions comply with HIPAA requirements (Dvorak; para. 30). It would have been obvious to add this feature to the Boyer teachings with the motivation of reducing erroneous security access (Dvorak; para. 30).

25. As per claim 20, Dvorak teaches a system for processing health care insurance claims, according to claim 1, wherein said carrier server further comprises a carrier audit processor for periodic review of said adjudicated payment requests for accuracy (Dvorak; para. 30). It would have been obvious to add this feature to the Boyer teachings with the motivation of reducing erroneous security access (Dvorak; para. 30).

26. As per claim 21, Dvorak teaches a system for processing health care insurance claims, according to claim 20, wherein said carrier audit processor supports payment tracking and detects fraudulent service delivery patterns (Dvorak; para. 30). It would have been obvious to add this feature to the Boyer teachings with the motivation of reducing erroneous security access (Dvorak; para. 30).

27. Claims 22-42 and 43-46 repeat substantially the same limitations as claims 1-21 and the reasons for rejection are incorporated herein.

***Response to Arguments***

28. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

29. Applicant argues on pgs. 14-16 that the applied references do not teach the features of independent claims 1 and 22. In light of the amended claims adding language to specify that the provider server is established at the health care service provider, Examiner has applied the Patricelli reference to show that this feature is old and well known in the art.

30. As per claim 7, Applicant argues Boyer does not teach an "expert review processor." Claim 7 teaches a provider expert review processor for securely storing and processing a treatment plan file said file including treatment plan and supporting data. According to MPEP § 2106, USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). As the claim is written, the function of the "provider expert review processor" is to securely store and process treatment plan and supporting data. Although there may be no mention of "expert review" the "adjudication engine" and Boyer system performs the same function as the "expert review processor" taught by claim 7 even if not called by the same name.

31. As per claim 10, Boyer teaches the function of the "coordination of benefits" processor by allocating financial responsibility for the claim by determining the amount covered by the Policy Administrator (Col. 15, lines 53-65).

### ***Conclusion***

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/M. L./  
Examiner, Art Unit 3686  
11/5/09

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
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